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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,334	03/14/2001	Stephen J. Brown	7553.00019 / 01-0310	6688

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3626

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07/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/810,334	Applicant(s) BROWN, STEPHEN J.	
	Examiner Vivek D. Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-20 have been examined in this application. This is a Final Office Action in response to the "Amendment" and "Remarks" filed on May 7, 2007

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Number 5,897,493 to Brown.

(A) As per claim 19, in Brown teaches a storage medium for use in a server to communicate with one or more patient devices, the storage medium recording a computer program that is readable and executable by the server (Brown: Abstract), the computer program comprising the steps of:

(A) displaying a plurality of icons of a plurality of questions, a plurality of answers and a plurality of follow-up actions (Brown: Figure 5 and Col. 5, Ln. 52-62);

(B) receiving a selection to each of a particular question of said questions, a particular answer of said answers and a particular follow-up of said follow-up actions from a user (Brown: Figure 5 and Col. 5, Ln. 52-63);

(C) linking the icons of a particular question and the particular answer and the particular follow-up action (Brown: Figure 5, Col. 5, Ln. 52-62).

Art Unit: 3626

(D) converting the linked icons into a subsequent program (Brown: Figure 5 and Col. 5, Ln. 52-62) ; and

(E) transmitting the subsequent program to said one or more patient devices over a communication network (Brown: Figure 5, Col. 5, Ln. 52-62).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 9-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,897,493 to Brown in view of US Patent Number 5,765,139 to Bondy in further view of US Patent Number 6,584,445 to Papageorge and in even further view of US Patent Number 6,139,404 to Cairnes.

(A) As per claim 1, Brown teaches

a server comprising (Brown: Col. 4, Ln. 43-51);

a questionnaire generator for (i) generating a questionnaire comprising (a) one or more questions for determining at least one of a physical condition of said individual, a mental condition of said individual, and a behavior of said individual, and for transmitting said questionnaire from said server to said remotely programmable apparatus, wherein the apparatus is (a) associated with an individual and (b) remotely located from the server (Figures 2 and 5 ((94) and 98)) and Col. 5, Ln. 7-19);

and wherein said remotely programmable apparatus (Brown: Col. 4, Ln. 55-60) comprises:

a communication means for receiving said questionnaire and said script program from said server and for transmitting said responses to said server (Brown: Col. 4, Ln. 47-51);

a user interface for communicating said questionnaire and said script program to said individual and for receiving said responses (Brown: Col. 4, Ln. 49-51);

a memory for storing said questionnaire, said script program, and said responses (Brown: Col. 7, Ln. 1-9); and

a processor connected to said communication means, said user interface and said memory for executing said questionnaire and said script program to communicate said questions to said individual, to receive said responses to said questions, and to transmit said responses to said server (Brown: Col. 7, Ln. 11-17).

Brown does not teach an expression of risk for an individual and (b) a first number of answer options to each of said questions, wherein the expression of risk concerns a condition and (ii) associating each of the answer options with one of a second member of values representing a level of risk and Brown does not teach a profile generated for (i) generating a profile for said individual based on one or more aspects of care, the expression of risk and the level of risk and assigning a subsequent program to the individual based on the profile, however, this feature is taught by Papageorge (Col. 8, Ln. 44-47, Ln. 58-63 and Ln. 65-67 and Col. 9, Ln. 6-17).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Brown with the aforementioned teachings from Papageorge

Art Unit: 3626

with the motivation of having a means of helping patients make informed decisions, as recited in Papageorge (Col. 1, Ln. 14-24).

Brown does not teach the following (structural) feature which is taught by Bondy (Figure 2 (Arrows 210, 212, 214) and Col. 3, Ln. 30-35):

a database in a storage medium:

At the time of the invention, one of ordinary skill in the art would have been motivated to modify the teachings of Brown with the aforementioned teachings from Bondy with the motivation of having a means of automatically transforming data from one type of data structure into another type of data structure, as recited in Bondy (Col. 2, Ln. 15-20) (Note: One of ordinary skill in the art would recognize that a database permits a user to convert data into various formats).

The combined teachings of Brown in view of Bondy and in view of Papageorge do not teach that a database is indexed by an aspect of care, an expression of risk and a level of risk. Nor do the combined teachings of Brown and Bondy teach that the second number of values are greater than the first number of answer options, however, this feature is taught by Cairnes (Col. 21, Ln. 12-27). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Brown, Bondy and Papageorge with the above mentioned teachings from Cairnes with the motivation of having a means of customizing therapies for a particular patient according to their level of risk, as recited in Cairnes (Col. 21, Ln. 24-27).

(B) As per claim 2, in Brown the profile of said individual is updated based on follow-up responses (Brown: Col. 5, Ln. 63-Col. 6, Ln. 4).

Art Unit: 3626

(C) As per claim 3, in Brown the profile further comprises, a language of said individual, and a current health condition of said individual; and said script generator also tailors questionnaire and said script program in dependence upon said language and said current health condition of said individual (Brown: Col. 4, Ln. 59-60).

(D) As per claim 4, in Brown the questionnaire generator further generates a motivational profile and comprehension capacity profile of said individual based on one or more answers (Brown: Col. 8, Ln. 65-Col. 9, Ln. 8) and Papageorge (Col. 8, Ln. 58-61). The motivation of making this modification to the teachings of Brown is set forth above in the rejection of claim 1.

(E) As per claim 5, in Brown the subsequent program comprises: a request for additional responses (Col. 2, Ln. 18-25);

and educational information (Brown: Col. 5, Ln. 9-15 and Ln. 33-42).

(F) As per claim 6, in Brown the educational information is received by a server from an external source (Brown: Col. 10, Ln. 8-15).

(G) As per claim 7, in Brown the data relating to said physical condition of said individual comprises one or more measurements received by a server from a monitoring device connected to said apparatus (Brown: Col. 4, Ln. 61-Col. 5, Ln. 6).

(I) As per claim 9, in Brown the data related to said physical condition of said individual comprises electronic medical records received by said server from a services organization associated with said individual (Brown: Col. 8, Ln. 5-24).

(J) As per claims 10-16 and 18, this claim is substantially similar to claim 1-9, above, respectively, and is therefore rejected on the same basis as claim 1, as set forth above.

Art Unit: 3626

external source of additional educational information and means for transferring said additional educational information from said external source to said remotely programmable apparatus (Brown: Col. 10, Ln. 8-15).

6. Claims 8 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Papageorge and in further view of Bondy and in further view of Cairnes, as applied to Claims 1 and 10, above, respectively, in even further view of US Patent Application Publication 2002/0010597 to Mayer and in even further view of Official Notice.

(A) As per claims 8 and 17, Brown does not teach that the data related to the physical condition of the individual comprises electronic medical claims received by said server from a medical claims paying organization associated with said individual (Figure 5 and Section [0046]). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the system and method of Brown by adding the aforementioned feature from Mayer with the motivation of providing an enhanced computerized tool for maintaining and managing various aspects of patients' healthcare, as recited in Mayer (Section [0003]). Mayer does not explicitly recite medical claims, however, the Examiner takes Official Notice that it is well-known in the health care industry that medical claims comprise data relating to the physical condition of an individual (patient) (e.g. in the form of ICD and/or CPT codes) and at the time of the invention, one of ordinary skill in the art would have been motivated to have modified the teachings of Brown, Papageorge, Bondy and Mayer with this aforementioned teachings with the motivation of having a means of having a means of referencing the particular service a health care services organization is paying for when it is reimbursing a patient for a medical claim that has been made on behalf of the patient by a health care provider.

Art Unit: 3626

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, as applied to Claim 19, above and in even further view of Cairnes.

(A) As per claim 20, Brown does not teach a means of defining a position of said particular answer along a risk scale ranging from a low risk value to a high risk value, however this feature is taught by Cairnes (Cairnes: Col. 21, Ln. 21-27). The motivation for making this modification to Brown is the same as that set forth in the rejection of Claim 1, above.

Response to Arguments

8. Applicant's arguments filed on May 7, 2007 have been fully considered but they are not persuasive. Applicants arguments will be addressed in sequential order as they were addressed in the "Remarks" section filed on May 7, 2007.

(1) Applicants make several arguments that the Brown reference does not teach several of the features of the claimed invention. These arguments are moot in view of the new rejection over the Cairnes reference. Applicants also argue against the Claims Objections made in the previous Office Action. These arguments are moot now since the Claim Objections have been withdrawn.

(2) Applicants argue that there is no reasoning provided for combining the teachings of Brown and Bondy and the teachings of Papageorge with those of Brown in view of Bondy. However, as set forth in the rejection of the Claims above there is proper motivation provided for making these combinations.

(3) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

Art Unit: 3626

long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(4) Applicants argue, with regards to Claim 19, that the Brown reference does not teach the concept of linking icons. However, the Office would like to point out that Brown in fact does teach this feature in Figure 5. In Figure 5 of Brown only one of the icons can be chosen as an answer, therefore, these icons are linked because once the user selects one of the icons the other icons become inactivated. Applicants also claim that Claim 19 does not teach the step of converting the linked icons into a subsequent program. However, as noted in the rejection of Claim 19, above, the Brown reference does in fact teach all of these features.

(5) Applicants argue that the Brown reference does not comprise the language of an individual, however, Brown in fact does teach this feature (Col. 17, Ln. 24-31).

(6) With respect to Claims 8 and 17, the Office has taken Official Notice on medical claims as being well known in the health care industry and the "Response" filed on May 7, 2007 has not challenged this Official Notice. Applicants also argue that the Mayer reference is not prior art because it has not been established that the provisional application from May 2002 complies with 35 U.S.C. 112, first paragraph. However, the Office would like to respond to this argument by stating that this provisional application was examined and it does provide support for the features relied upon in Mayer to reject Claims 8 and 17.

(5) A telephone interview was conducted on April 24, 2007 and the Office indicated that the next Communication would be non-final, however, the applicants have amended the claims and

Art Unit: 3626

this has resulted in the new grounds of rejection, therefore as per Office practice this communication must be made final.

Conclusion

9. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").


Art Unit: 3626

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,


Vivek Koppikar

7/19/2007


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600